

expire on July 18, 2004.

Applicant respectfully requests reconsideration of the restriction for the reasons and analyses set forth in this Response.

Barring reconsideration of the restriction requirement, Applicant elects to prosecute Claims 1-6 in Group I, with traverse.

### **Remarks**

Applicant agrees with the Examiner's finding that the alleged separate inventions are patentable over each other. Applicant disagrees, however, with the Examiner's finding that the components of the ditch liner system grouped by the Examiner are sufficiently independent or distinct to warrant a restriction in accordance with the groupings of claims made by the Examiner.

As the Examiner knows, 35 U.S.C. §121 fails to provide an accepted definition of what is meant by *independent* and *distinct*. Thus, although MPEP §802.01 gallantly tries to "define" *independent* and *distinct*, the Commissioner acknowledges that "the terms 'independent' and 'distinct' are used in decisions with varying meanings...[and that] all decisions should be read carefully to determine the meaning intended." See MPEP §802.01.

MPEP §800 *et seq.* further compounds analytical confusion. MPEP §803 incorrectly suggests that the test for restriction is whether an applicant's claims are directed to *independent* or *distinct* inventions, while 37 CFR 1.142 is addressed to *independent and distinct* inventions.

Focusing, therefore, on what are at best inadequate tests for a restriction requirement, Applicant submits that the claims under consideration ought not be restricted because they are neither independent nor distinct, and that the Examiner therefore, on reconsideration, should withdraw the restriction requirement.

### **The Subject Matter is Dependent**

MPEP §802.01 suggests that the word *independent* means, obviously, that something is not dependent, and that being not dependent "means that there is no disclosed relationship between the two or more subjects disclosed, [and that they are]...unconnected in design, operation, or effect."

The application under examination, however, shows that the inlet/outlet box, splitter section, diversion section, and adaptor are in fact connected in design, operation, and effect not

only among themselves, but with the subject matter of claims in the parent application that have since matured into U.S. Patent No. 6,692,186 B1, issued February 17, 2004. The parent application provides in part:

As used in this document, the terms “ditch liner section,” “liner section,” “liner,” and “section” mean, without limitation, the components described in this document that may be removably connected to form the apparatus, method and system for transporting water in accordance with the present invention. The terms therefore include a ditch liner section, an inlet/outlet box or channel, a diversion section, an adaptor, and a splitter section as described and claimed in this document.

See Application, page 5, lines 13-20.

While additional content of the parent application could be set forth to emphasize the point, including references to the drawing figures, the foregoing shows that the inlet/outlet box, splitter section, diversion section, and adaptor are in fact connected in design, operation, and effect, and are, therefore, dependent.

#### **The Subject Matter is Distinct**

MPEP §802.01 also purports to define *distinct*, but provides no case law reference to the definition. Rather, that section suggests that the term *distinct* means that although the subject matter is to be used in combination, the components are distinct if “capable of separate manufacture, use, or sale.” This assertion of a “definition” must be tempered, of course, by the limitation stated in that same section, namely that “the terms ‘independent’ and ‘distinct’ are used in decisions with varying meanings...[and that] all decisions should be read carefully to determine the meaning intended.”

As a person skilled in the art would undoubtedly conclude from a review of the application being examined, the inlet/outlet box, splitter section, diversion section, and adaptor are not distinct inventions. The components are to be used with the ditch liner sections; they have no conceivable “use” separate and apart from the ditch liner section, or separate and apart from each other.

The term *distinct* certainly is not limited to the notion of “separate manufacture,” itself a term of questionable meaning. The notion of “separate manufacture” is but one of the three tests suggested. If by “separate manufacture” the definition presupposes that the subject matter under consideration could be manufactured “separately” from the liner to which they are attached, that

fact does automatically or necessarily mean that the components of the ditch liner system are “distinct inventions.” Inversely, nothing in the nature of manufacturing is of record that would indicate that the inlet/outlet box, splitter section, diversion section, and adaptor could not be manufactured, for example, by rotational molding as components of a unitary body.

That leaves the question of “sale” standing alone in the clause setting forth the “definition” of *distinct*: are the components “capable of separate...sale....” Applicant acknowledges that almost any component of a mechanical system *may* be separately sold. But should that fact lead inexorably to a restriction in this case, given that Applicant has refuted the other arguments in connection with the words *independent* and *distinct*? Applicant thinks not, and accordingly asks the Examiner to reconsider the restriction requirement.

### **Classification System**

In this regard, in an office action issued by the Examiner as part of Paper No. 7 during prosecution of the parent application, Application Serial No. 10/316,756, the Examiner stated in paragraph 1 that the arguments advanced by Applicant against the original restriction requirement in Paper No. 5 did not point out the reasons why the decision to restrict was in error. The Examiner felt that Applicant’s arguments did not show why the claims are not independent and distinct.

Applicant respectfully disagrees.

Applicant expressly pointed out in Applicant’s Response to Office Action Number 01, Paper No. 6, that nothing in the Classification System of the Office mandated the restrictions. Applicant’s arguments made in that paper, and reiterated here.

The Examiner asserts in paragraphs 1-4 of the present Office Action, pages 2-3, that a basis for the restriction between the claims in Group I and Groups II-IV are that the respective claims are to be classified in different classes and subclasses. Applicant has reviewed the current classification definitions. Applicant respectfully disagrees with the Examiner’s conclusions.

The class definition for class 405 is sufficiently broad in scope to include all the claims of the application in a single group for examination, given the context of the application as a whole.

Further, the subclasses mentioned in Groups II-V could as well be sub-classified in a single Group, for example, under subclass 40.

The claims under Groups III and IV, having been placed under subclass 51 could, therefore, be grouped together.

Applicant, therefore, submits for the Examiner's consideration that claims under consideration could be grouped under a single group for classification and restriction requirements.

Accordingly, Applicant requests that all claims under consideration be examined together.

Finally, Applicant also submits that there is no proof that the Examiner's findings in paragraphs 2-4 of the Office Action are correct. There is nothing of record, for example, that supports the proposition that the present invention is, for example, comparable to a rain gutter, or that the inventions in Groups II-V are separately usable, or have separate utility. Thus, while the alleged separate inventions are patentable over each other, there is no proof that the alleged separate inventions are capable of separate manufacture, use or sale.

#### **Summary**

Applicant also urges the Examiner to recognize that a restriction is not mandatory; it is permissive. "If two or more independent and distinct inventions are claimed in one application, the Director may require the applicant to be restricted to one of the inventions." See 35 U.S.C. §121.

Applicant has shown that the subject matter is clearly dependent. Applicant has shown that the subject matter is not for use except with the ditch liners. Applicant has shown that the subject matter is not both independent and distinct.

Given the classifications of the related subject matter, the search and examination of the entire application can be made without serious burden, the Examiner should examine the divisional application on its merits. See MPEP §802.01, which provides: "If the search and examination of the entire application can be made without serious burden, the examiner must examine [the application] on its merits, even though it includes claims to independent or distinct inventions."

The Examiner also should consider the obverse side of the "serious burden" issue: the serious financial burden imposed on Applicant to secure four separate patents in connection with a cluster of related, interdependent non-distinct apparatus functionally associated with the liners

for which the inlet/outlet box, splitter section, diversion section, and adaptor were designed for use.

The claims under consideration do not present the more typical bases for restriction, where the two inventions are process and apparatus. Rather, the claims are different combinations that Applicant has disclosed as being "capable of use together." See MPEP §806.04(A). These facts also support reconsideration by the Examiner.

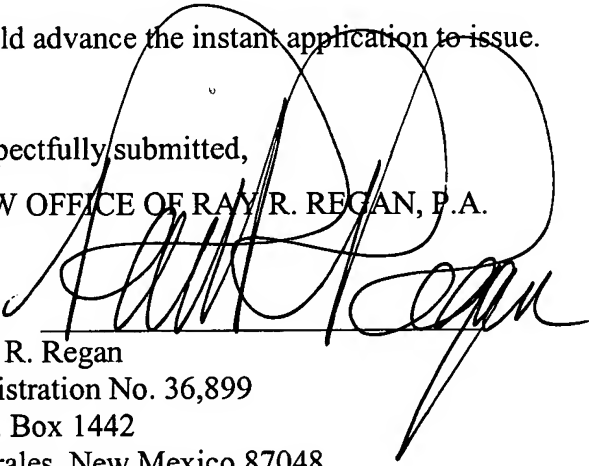
### Conclusions

Therefore, Applicant submits that the claims subject to restriction in this case are neither independent nor distinct. Applicant respectfully requests reconsideration and withdrawal by the Examiner of the restriction requirement.

If the Examiner is unwilling to reconsider and withdraw the restriction requirement, Applicant is compelled by the Rules to elect to prosecute one grouping of claims, and Applicant therefore elects to prosecute the claims of Group I, namely claims 1-6, as categorized by the Examiner in the present office action.

The Examiner is requested to call the undersigned as (505) 897-7200 for any reason that would advance the instant application to issue.

Respectfully submitted,  
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